

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TIMOTHY J. YOUNG, LARRY T. SCHLITZER,  
KEVIN E. YOUSEY AND KEVIN S. REITTER

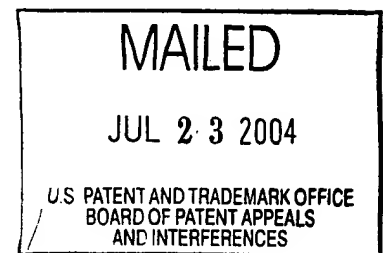
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Appeal No. 2004-1415  
Application 09/772,177

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ON BRIEF

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Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.  
FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner for appropriate action with regard to the items listed below.

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1. In reviewing the application file, we are at somewhat of a loss to understand the current status of claim 14. In the final rejection (Paper No. 5) claim 14 and claim 9, from which claim 14 depends, were both rejected under 35 U.S.C. § 102(b) as being anticipated by Moe et al. (US 5,659,851). However, for reasons which are not apparent from the record, in the advisory action mailed March 18, 2003 (Paper No. 8) dependent claim 14 was indicated to be "allowed," while parent claim 9 was still indicated as rejected. Claim 14 adds to the web tracking apparatus of parent claim 9 that the steering roller therein is "mounted on a roller shaft." Since the steering roller (14) of Moe et al. pointed to by the examiner in the rejection of parent claim 9 is clearly mounted on a roller shaft (59), we fail to see why claim 14 is considered by the examiner to be "allowed." Clarification of the status of claim 14 is required.

2. On February 11, 2004 appellants filed a reply brief, (Paper No. 15). The reply brief includes arguments responsive to the examiner's position as set forth in the examiner's answer (Paper No. 14). In response to the reply brief, the examiner sent out Paper No. 16 (March 4, 2004) informing appellants that the reply brief had been "entered and considered" and that the

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application was being forwarded to the Board of Patent Appeals and Interferences for decision on the appeal. Our problem is that the examiner has not provided us with her position concerning the various arguments presented by appellants in the reply brief. Thus, we remand the application to the examiner for a response on the record to the arguments raised by appellants in their reply brief.

3. In the paragraph bridging pages 5-6 of the brief and in the reply brief (page 3), appellants have pointed to the definition in their specification concerning what "biasing" means in the context of the present application, and urged that this definition properly applied to the claimed biasing and adjustment necessary to achieve the desired tracking as set forth in the claims on appeal distinguishes over the web tracking systems and methods in either Moe et al. or Morse (US 3,913,813). We fail to find where in the answer the examiner has responded to this specific argument. Thus, we remand the application for the examiner to address this issue.

4. On page 6 of the brief and in the reply brief (page 3), appellants have challenged the examiner's position in the rejection of claim 9 on appeal with regard to both the "means for biasing" and "means for adjusting said bias to achieve desired tracking," by urging that the structure (94, 96) in Moe et al. pointed to by the examiner as corresponding to such means are not properly responsive to appellants' claimed means and that such structure in Moe et al. fails to perform the recited functions of "biasing" and "adjusting said bias to achieve desired tracking." We find no clear response in the answer to this line of argument. As was made clear in In re Donaldson Co. Inc., 16 F.3d 1189, 1193, 29 USPQ2d 1845 (Fed. Cir. 1994), the sixth paragraph of 35 U.S.C. § 112 permits an applicant to express an element in a claim for a combination as a means or step for performing a specified function without the recital of structure, materials or acts in support thereof, and mandates that such a claim limitation "shall be construed to cover the corresponding structure, materials, or acts described in the specification or equivalents thereof." In this case, it is clear to us, that the examiner has not as of yet properly construed the above-noted

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limitations of claim 9 on appeal or established a *prima facie* case of equivalence. Accordingly, we remand for the examiner to provide a proper analysis of the "means" clauses of appellants' claim 9.

If appropriate, a supplemental examiner's answer clarifying the issues discussed above is authorized. It follows that appellants should have an opportunity to respond to any such supplemental answer by way of a further reply brief. Note, for example, 37 CFR § 1.193(b)(1) and (b)(2).

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This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D), Eighth Edition, Rev. 1, Feb. 2003. It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REMAND TO THE EXAMINER



NEAL E. ABRAMS )  
Administrative Patent Judge )



CHARLES E. FRANKFORT )  
Administrative Patent Judge )

BOARD OF PATENT  
APPEALS AND  
INTERFERENCES



JEFFREY V. NASE )  
Administrative Patent Judge )

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